

Case C-329/02 P

SAT.1 SatellitenFernsehen GmbH

v

**Office for Harmonisation in the Internal Market
(Trade marks and Designs) (OHIM)**

(Appeals — Community trade mark — Absolute grounds for refusal to register —
Article 7(1)(b) and (c) of Regulation (EC) No 40/94 — ‘SAT.2’)

Opinion of Advocate General Jacobs delivered on 11 March 2004 I - 8322

Judgment of the Court (Second Chamber), 16 September 2004 I - 8338

Summary of the Judgment

1. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Separate examination of the different grounds for refusal — Interpretation of the grounds for refusal in the light of the general interest underlying each of them*

(Council Regulation No 40/94, Art. 7(1))

2. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Lack of distinctive character of the sign — Public interest underlying Article 7(1)(b) of Regulation No 40/94 — Scope*
(Council Regulation No 40/94, Art. 7(1)(b))
3. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Lack of distinctive character of the sign — Word mark consisting of several features — Taking into account of the overall perception of the combination by the relevant public*
(Council Regulation No 40/94, Art. 7(1)(b))
4. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Lack of distinctive character of the sign — Insufficiency of the finding of the absence of a specific level of linguistic or artistic creativity or imaginativeness to deny the distinctiveness of the sign — Trade mark not being descriptive of the goods and services covered — Obligation for the Office to set out the reasons for the lack of distinctive character*
(Council Regulation No 40/94, Art. 7(1)(b) and (c))
5. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Trade marks devoid of any distinctive character — 'SAT.2'*
(Council Regulation No 40/94, Art. 7(1)(b))

1. Each of the grounds for refusal to register listed in Article 7(1) of Regulation No 40/94 on the Community trade mark is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations

according to the ground for refusal in question.

(see para. 25)

2. The public interest underlying Article 7 (1)(b) of Regulation No 40/94 on the Community trade mark, concerning the ground for refusal based on the lack of distinctive character of a mark, is aimed at the need not to restrict unduly the availability of that trade mark for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought. Furthermore, in view of the extent of the protection afforded to a trade mark by the regulation, the public interest underlying that provision is, manifestly, indisociable from the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

By contrast, a criterion which is not the yardstick against which Article 7(1)(b) should be judged is the criterion according to which trade marks which are capable of being commonly used, in trade, for the presentation of the goods or services in question may not be registered, which is a criterion that is relevant in the context of Article 7(1)(c). Furthermore, taking the view that the provision of Article 7(1)(b) pursues an aim which is in the public interest, which

requires that the signs they refer to may be freely used by all, involved deviating from taking into account the public-interest criterion referred to above.

(see paras 23, 26, 27, 36)

3. When assessing the distinctive character of a trade mark within the meaning of Article 7(1)(b) of Regulation No 40/94 on the Community trade mark, and where a trade mark comprising words or a word and a digit is involved, the distinctiveness of each of those terms or elements may be assessed, in part, in relation to each of those words or figures taken separately but must, in any event, depend on an appraisal of the whole which they comprise. Indeed, the mere fact that each of those elements, considered separately, is devoid of distinctive character does not mean that their combination cannot present a distinctive character.

It would be wrong to interpret that provision by assessing the distinctive character of a phrase composed of several elements essentially by means of a separate analysis of each of its elements, and by taking as a basis, for that purpose, the presumption that elements individually devoid of distinctive character cannot, on being combined, present such a character rather than the overall perception of that term by the average consumer, and by exam-

ining the impression as a whole produced by the term only secondarily, refusing to give any relevance to aspects such as the existence of an element of imaginativeness, which ought to be taken into account in such an analysis.

In that regard, the frequent use of trade marks consisting of a word and a number in a given sector indicates that that type of combination cannot be considered to be devoid, in principle, of distinctive character.

(see paras 41, 42, 44)

(see paras 28-29, 35)

4. Registration of a sign as a Community trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.

5. Although the way in which the term 'SAT.2', for which registration as a Community trade mark is applied for, for the following services in Classes 38 and 41 of the Nice Agreement

- Class 38: 'Wireless or hard-wire networked broadcast of radio and television transmissions/programmes; broadcasting of film, television, radio, video text and teletext programmes or transmissions; arranging and allocating of user passwords for users of various communication networks; telecommunications; gathering, delivering and transmitting messages, press reports (including using electronic means and/or by computer); transmission of sound and images by means of satellites; broadcasting Pay TV including video on demand, including for others on a digital platform; services relating to telecommunications; providing information to

Where a trade mark which does not fall foul of the ground of refusal laid down in Article 7(1)(c) of Regulation No 40/94 is none the less devoid of distinctive character within the meaning of Article 7(1)(b) thereof, the Office for Harmonisation in the Internal Market (Trade marks and Designs) must also set out the reasons why it considers that that trade mark is devoid of distinctive character.

others; dissemination of information via wireless or cable networks; on-line services and transmissions, namely transfer of information and messages including E-mail; operation of networks for the transfer of messages, images, text, speech and data; broadcasting of teleshopping programmes’;

recording, transmission, storing, processing and reproduction of sound and images; organising radio and television broadcasts/programmes; production of teleshopping programmes’;

- Class 41: ‘Production, reproduction, showing and rental of films, videos and other television programmes; organisation and conducting of shows, quizzes and musical events and conducting competitions in the entertainment and sporting field, including for recordings or being live broadcasts on radio or television; production of television and radio advertising broadcasts including associated prize game broadcasts; production of film, television, radio, teletext and videotext programmes or transmissions, radio and television entertainment;

is made up is not unusual, in particular as regards the perception which the average consumer may have of services falling within the communications industry, and the juxtaposition of a verbal element such as ‘SAT’ with a digit such as ‘2’, separated by a ‘.’ does not reflect a particularly high degree of inventiveness, those facts are not sufficient to establish that such a word is devoid of distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94.

(see para. 40)